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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/826,767

04/16/2004

Thomas M. Conway

6570-91244

1286

24628

7590

05/10/2006

WELSH & KATZ, LTD  
120 S RIVERSIDE PLAZA  
22ND FLOOR  
CHICAGO, IL 60606

EXAMINER

STERLING, AMY JO

ART UNIT

PAPER NUMBER

3632

DATE MAILED: 05/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/826,767	<b>Applicant(s)</b> CONWAY ET AL.	
	<b>Examiner</b> Amy J. Sterling	<b>Art Unit</b> 3632	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 9-12 is/are rejected.
- 7) ☒ Claim(s) 5-8 and 13-16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/9/06</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This is the first Office Action for application number 10/826,767, Bias-Sign With Floating Mount System, filed on 4/16/04. Claims 1-16 are pending.

### ***Election/Restrictions***

No claims are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, but species I has been elected, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 3/9/06.

### ***Information Disclosure Statement***

The information disclosure statement submitted on 3/9/06 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been considered by the examiner.

### ***Drawings***

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: reference numeral 10 does not appear in the drawings.

Also, the drawings are objected to for poor line quality and shading both of which are not permitted. In addition the reference numerals are difficult to distinguish.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 1 recites that "the upper and lower mount portions mounted to the spine...having a biasing element securing portion." The specification teaches that the biasing securing portion 42 is on the arms (See page 5, paragraph 0030).

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 9 recite the limitation "the latch fastener". There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by United States Patent No. 2787433 to Slavsky et al.

The patent to Slavsky et al. discloses a sign mounting system for mounting an associated sign to an associated structure, the structure including a vertical upright post

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having a face having a plurality of vertically extending, spaced apart openings, the mounting system having a spine (1) adapted to mount to the vertical post, the spine have a face portion, upper and lower mount portions (11, 12) mounted to the spine, at least one of the upper and lower mount portions having a biasing element securing portion (pivot bolt) an upper arm (14) and a lower arm (15) mounted to respective upper and lower mount portions, the upper and lower arms (14, 15) each having a pivot portion defining a pivot axis (straight through pivot bolt) about the mount portion, the pivot axes being collinear, at least one of the upper and lower arms having a biasing element securing portion (the pivot bolt) a biasing element (20, 21) operably connecting the upper or lower arm to its respective mount portion at the respective biasing element securing portions, wherein the arm is pivotal between first and second positions and is biased toward the first and second positions by the biasing element; and a floating insert (6, 7, 8) for mounting the spine to the upright, the floating insert having a body portion for engaging the spine and the upright and for spacing the spine face from the upright face, the floating insert having a latch portion (8, 6) having a threaded stud disposed in the body portion, the latch portion engageable with the upright the latch portion including a fastener (6, 8) extending therefrom wherein when the floating insert is engaged with the upright and the latch fastener is engaged with the spine, the spine is secured to the upright with the face portion of the spine spaced from the face of the upright, wherein the floating insert includes a central support portion (7) and depending legs (8) extending from the central support portion and tabs on the legs urged inwardly

toward one another (See ends of legs), the tabs which could also be defined as a finger and a first hook element spaced from one another and opposedly oriented.

Claims 9-12 are rejected under 35 U.S.C. 102(e) as being anticipated by United States Patent Publication 2004/0195483 to Padiak et al.

Padiak et al. teaches a floating insert (90) having a body portion and a latch portion disposed on the body portion the latch portion including a fastener (92) extending therefrom wherein the floating insert is engaged with the upright (25) and the latch fastener is engaged with the spine (20), wherein the spine is secured to the upright (25) with the face portion of the spine spaced from the face of the upright, wherein the body portion includes a central support portion (93) and depending legs (913) extending from the central portion, the legs including tabs (inward portion of 913) formed in the depending legs urged inwardly toward one another with a finger (opposite 914) and a hook element (914) spaced from one another and being opposedly oriented.

#### ***Allowable Subject Matter***

Claims 5-8 are objected to as being dependent upon claims rejected under 35 USC 112, first paragraph, but may be allowable depending upon clarification of the claim 1. The claims are considered, however, considered fully rejected and the next action may be made final.

Claima 13-16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following documents show various sign holders

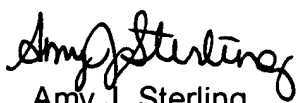
6691963 to Padiak et al.

6086033 to Calleja

4218036 to Pitkanen

3637178 to Golden

Any inquiry concerning this communication should be directed to Amy J. Sterling at telephone number 571-272-6823. The examiner can normally be reached (Mon-Fri 8am-5:00pm). If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached at 571-272-6788. The fax machine number for the Technology center is 571-273-8300 (formal amendments), informal amendments or communications 571-273-6823. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center receptionist at 571-272-3600.

  
Amy J. Sterling  
5/6/06